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Attention: MAIL STOP: APPEAL BRIEF

Company: USPTO

Re: App. No. 09/727,908; Docket No. Palm-3216

Cover Message:

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Berry & Associates, P.C.

TRANSMITTAL FORM	Application Number: 09/727,908
	Filing Date: November 30, 2000
(to be used for all correspondence after initial filing)	First Named Inventor: Scott Johnson
	Art Unit: 2131
	Examiner Name: Arezoo Sherkat
Total Number of Pages In This Submission	Attorney Docket Number: PALM-3216

ENCLOSURES   *(Check all that apply)*

- [✔] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
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- [ ] Response to Missing Parts/Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53

- [ ] Drawing(s)
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- [ ] Petition to Convert to a Provisional Application
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- [ ] After Allowance communication to Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [✔] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
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Firm or Individual name	Thomas M. Isaacson, Reg. No. 44166
Signature	*[signature]*
Date	September 9, 2005

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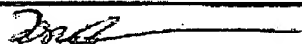**CENTRAL FAX CENTER**

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FEE TRANSMITTAL
For FY 2005

[✓] Applicant claims small entity status. See 37 CFR 1.27

Complete if Known	
Application Number	09/727,908
Filing Date	November 30, 2000
First Named Inventor	Scott Johnson
Examiner Name	Arezoo Sherkat
Art Unit	2131
Attorney Docket No.	PALM-3216

TOTAL AMOUNT OF PAYMENT ($) 250

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	Small Entity Fee ($)	SEARCH FEES Fee ($)	Small Entity Fee ($)	EXAMINATION FEES Fee ($)	Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)		Multiple Dependent Claims Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____ x	_____ =	_____		_____	_____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____ x	_____ =	_____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____ - 100 =	_____ / 50 =	_____ (round up to a whole number) x	_____ =	_____

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Non-English Specification, $130 fee (no small entity discount)

	Fees Paid ($)
Other (e.g., late filing surcharge): Submission of Appeal Brief	250.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 44,166	Telephone 410-414-3056
Name (Print/Type) Thomas M. Isaacson			Date September 9, 2005

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Patent Application No. 09/727,908   Docket Number: PALM-3216   **SEP 1 0 2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :

Scott Johnson   :   Confirmation No. 3695

Serial No. 09/727,908   :   Art Unit: 2131

Filed: November 30, 2000   :   Examiner: Arezoo Sherkat

FOR: A METHOD AND SYSTEM FOR :
SECURE ACTIVATION OF WEB   :
CLIPPING APPLICATIONS   :

APPEAL BRIEF

MAIL STOP: Appeal Brief
ASSISTANT COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This Appeal Brief is submitted in triplicate in response to the Final Office Action,

January 12, 2005 and the Advisory Action, dated May 4, 2005 and in support of the Notice of

Appeal, filed July 12, 2005.

1.   **REAL PARTY IN INTEREST**

The real party in interest in this matter is PalmSource, Inc.

2.   **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

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3.   STATUS OF THE CLAIMS

Claims 1 - 20 are pending in this application. (See the Appendix). Independent claims 1, 9 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of U.S. Patent No. 6,067,109 to Kikinis ("Kikinis") and U.S. Patent No. 6,611,812 to Hurtado ("Hurtado").

4.   STATUS OF AMENDMENTS

The claims have not been amended during prosecution. The claims as originally filed are attached.

5.   SUMMARY OF THE CLAIMED SUBJECT MATTER

The claims recite a method and system for accessing a proxy service. Claim 1 recites a method practiced in an electronic device that comprises preventing a user from accessing web clipping applications that are installed on the electronic device and located within the installed software. The user registers the electronic device with a proxy service using a registration application of the installed software and upon authorized registration of the electronic device with the proxy service, the method allows the web clipping applications to be made available for use by the user and otherwise prevents access of the web clipping applications by the user.

6.   Ground of Rejection to be Reviewed on Appeal

(1)   Whether claims 1 - 20 are appropriately rejected under Section 103 and whether the Examiner has extablished by a preponderance of the evidence that one of skill in the art would be motivated to combine Kikinis with Hurtado.

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7.   GROUPING OF CLAIMS

The claims may be grouped as follows.

1.   Claims 1 - 14 are method claims.

2.   Claims 15 - 20 system claims.

A separate basis for patentability exists for each group of claims. However, except to

the extent otherwise indicated below, the respective groups of claims stand or fall together

for purposes of this appeal.

8.   ARGUMENT

A.   The Examiner has Mis-applied the Law in the Obviousness Analysis Under Section 103.

The Examiner rejects claims 1 - 20 under Section 103 over Kikinis in view of

Hurtado. Applicants have traversed this rejection and provided numerous reasons why under

the proper standard of a preponderance of the evidence, insufficient motivation exists to

combine Kikinis with Hurtado. The Examiner has not addressed or analyzed any teachings

or evidence presented by Applicants that lead away from combining these references.

Applicants responded in April 2005 to the Final Office Action and provided a number

of reasons why insufficient motivation exists to combine these references. For example,

Applicants explained how Kikinis focus on extending the battery life of a handheld device

and in contrast, how Hurtado focuses on delivering encrypted digital content to an end user

for playing the content. Hurtado's invention relates to protecting digital content from piracy.

Applicants analyzed the power of suggestion of the entire teachings of each of the references

as is required by the MPEP. Applicants arguments are fully set forth in the previous response

to the Final Office Action.

The Examiner responded that although claims are examined in light of the

specification, the Examiner "shall not read the specification into the claims." Applicants

respectfully submit that the Examiner is mis-applying the obviousness analysis by believing

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that Applicant's arguments are reading limitations from the specification into the claims. When studying each reference for its suggestive power in terms of being combined with another reference, the reference is considered in its entirety, as a whole, including portions that would lead away from the claimed invention MPEP 2141.02. Each reference must be weighed for its suggestive power to suggest solutions to one of skill in the art. MPEP 2143.01. Therefore, the analysis of the suggestive power of each reference is <u>independent</u> of the present specification and simply does not amount to "reading the specification into the claims" as mentioned by the Examiner.

B.   Additional Reasons Exist to Prevent the Combination of Kikinis with Hurtado.

Applicants will not repeat the previous arguments set forth in the response to the Final Office Action but will incorporate those arguments and set forth several additional arguments leading away from combining these references. Applicants urge that it will become clear that the preponderance of the evidence leads away from finding motivation to combine these references.

First, note the title of Hurtado: "Secure Electronic Content Distribution on CDs and DVDs." With the understanding that Kikinis teaches a proxy-server method of browsing the Internet for low-end portable computing devices, the suggestive power of Hurtado when one of skill in the art would read its title would lead a person away from combining these references. The suggestive power of the title of Hurtado clearly limits its scope to CD and DVD content. The Abstract discusses reading from a computer readable medium (DVD, CD) metadata which was previously associated with the content. Therefore, from the first information that would be presented to a person about the scope and content of Hurtado (from the title and abstract), they limit their teachings to CD and DVD technology. Applicants submit that one of skill in the art, under a preponderance of the evidence, would naturally conclude that Hurtado's focus on CD and DVD technology would not easily or

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possibly be utilized in Kikinis' proxy server application. For example, Kikinis' title: "Simplified File Hyper Text Protocol" and its abstract which discusses transposing data files to an alternative, low-information-density form for transmission to low-end battery powered computers, do not suggest to one of skill in the art that this concept would lend itself to be blended with Hurtado's DVD encryption technology where there (1) is no network and (2) no downloading of files over a network as it is introduced.

Applicants submit that where the MPEP requires the Examiner to consider the overall suggestive power of each reference, that the title and abstract cannot be ignored for their suggestive power. This applies especially where their practical aids readers to determine whether to explore the further details within the patent.

Now, Applicants certainly recognize that Hurtado do mention the Internet in addition to CDs and DVDs, within the body of the patent. However, this does not enable a conclusion that it would be obvious to combine these references. Another reason there is insufficient motivation to combine given the suggestive power of each reference is that Hurtado is still focused on media content delivery. Throughout Hurtado it is clear that they want to protect digital assets such as films, games, and music. Col. 1, lines 15 - 20. Where streaming video is a primary type of media content, as well as other streaming content, Applicants submit that this disclosure of Hurtado further limits its suggestive power to be combined with Kikinis. The reason is that Kikinis is primarily an HTML - web - page or single image based proxy server system. For example, HTML files are mentioned throughout. Col. 1, line 59; col. 7, line 29; col. 10 in general; col. 12, line 15, etc. Regarding images, Kikinis mentions JPEG files becoming reduced in content for browsing on the portable device. Col. 7, lines 30-34. They mention that multi-page files are recombined into single file pages to minimize bandwidth. Col. 7, line 33-34.

The overall suggestive power that Kikinis' idea could apply to streaming video minor

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in comparison to its overall thrust. In other words, their invention is a web-page by web-page transformation into a lower-bandwidth image. Applicants respectfully submit that Kikinis' approach less desirable for video content which is an important feature of Hurtado and streaming content is a primary focus of Hurtado. Therefore, because one of skill in the art would recognize that Kikinis' method of converting HTML web pages (or other single-page content) into lower-bandwidth data for portable devices is less desirable for streaming media content. Applicants recognize that in column 6, Kikinis mentions translating video or audio content into a simpler protocol to send to the portable computer. The obviousness standard does not rest on whether a combination of references is possible but whether the references suggest or provide motivation for their combination. Given the suggestive power of each reference, Applicants submit that the preponderance of the evidence does not support combination.

In sum, the following are teachings within the references the lead away from motivation to combine these references:

In Kikinis:

(1)   The fact that Kikinis focuses on low-end computers on battery power;

(2)   The fact that this reference primarily teaches HTML webpage conversion to low bandwidth data;

(3)   The fact that converting video and audio content amounts to a minor point in the overall disclosure;

(4)   The fact that the title and abstract of Kikinis mention the Hyper Text Protocol and "transposing data files" with no mention or suggestion of streaming media; and

(5)   The fact that this reference is Internet-based (see (X) below).

In Hurtado:

(1)   The fact that the title and abstract only reference CDs, DVDs and "computer

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readable medium" with no suggestion of a network connection;

(2)   The fact that the primary focus of this reference is on film, media and games or other streaming media and not HTML or single web page processing;

(3)   The summary of the invention only references a "computer readable medium" without suggesting an Internet application; and

(4)   The substance of Hurtado as outlined in columns 7, 8 and 9 wherein such features discussed in the patent include "Content Quality Control Process"; "Final Quality Assurance Process"; "Final Quality Assurance Tool" and so forth, make it clear that high quality (high bandwidth) content is delivered either via a DVD or over a network;

(5)   End user devices are never discussed as low-end low resolution devices - the IRDs or personal computers all receive high quality digital media content;

(6)   Hurtado focuses on content delivery either through a broadcast system such as satellite or cable (columns 81, 82 - Broadcast Electronic Digital Content Distribution System) or via delivery of a CD or DVD (columns 83-84 - Delivery Over A computer Readable Medium). Specifically, in this delivery approach, Hurtado states: "The difference lies in that the encrypted Content 113 is not downloaded from the Content Hosting Sites(s) 111, but rather the Content 113 is read in Content SC(s) 630 stored on CD 1802." Col. 84, lines 3 - 6.

C.   **Summary and Conclusion**

The issue before the Board of Appeals is not whether these references can technically be combined. The Examiner's conclusion is that Hurtado focuses on protecting content from being pirated and that preventing piracy includes preventing a user from accessing electronic content on an electronic device. Comments, Advisory Action. However, as can be seen above, when an appropriate analysis of the suggestive power of each reference is performed, it becomes clear that there are a lot of teachings in each reference that technically and substantially lead away from giving the requisite motivation or suggestion to one of skill in

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the art to combine these references. Applicants submit the primary teachings as evidenced by

the titles, abstracts and summaries, and weight of the disclosures for each of these references

lead away from motivation to combine. Where snippets of information may exist in the

references that can be cited to support a motivation to combine, Applicants have recognized

those instances (the Examiner has not recognized or analyzed any teaching that does not

support his conclusion) and included them in the analysis above. However, when all the

evidence is weighed, the scales are tipped towards a conclusion that there is insufficient

motivation to combine Kikinis with Hurtado.

Accordingly, Applicants request that the Board of Appeals overturn the rejection of

claims 1 - 20 and find that these claims are patentable over these references.

Applicants request oral argument on the matter.

If necessary, the Commissioner is hereby authorized to charge the appeal brief fee of

$250.00 and any additional fees, and credit any fees, which may be necessary for

consideration of this paper to charge account 50-3102. A copy of this sheet is enclosed for

that purpose.

Respectfully submitted,

Date: September 9, 2005   /Thomas M. Isaacson/
Correspondence Address: Thomas M. Isaacson
Customer Number: 49637   Reg. No. 44,166
                                                Phone: (410) 414-3056
                                                Attorney for Applicants

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APPENDIX

(Brief of Appellants
U.S. Patent Application Serial No. 09/727,908)

CLAIMS ON APPEAL

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CLAIMS

What is claimed is:

1.   In an electronic device having installed software therein for accessing a proxy server, a method comprising the steps of:

a) preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software;

b) said user registering said electronic device with said proxy server using a registration application of said installed software; and

c) upon authorized registration of said electronic device with said proxy server, allowing said web clipping applications to be made available for use by said user and otherwise preventing access of said web clipping applications by said user.

2.   The method of Claim 1 wherein said electronic device is a personal information device (PID) comprising handheld organizers. cellular phones, laptop computers, and pagers.

3.   The method of Claim 1 wherein said step a) of preventing a user from accessing web clipping applications is comprised of:

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preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software by hiding said web clipping applications within said installed software until such time that said device is registered with said proxy server.

4.   The method of Claim 3 wherein said step c) of allowing said web clipping applications to be made available is comprised of:

upon authorized registration of said electronic device with said proxy server, revealing said web clipping applications to said user and otherwise preventing access of said web clipping applications by said user.

5.   The method of Claim 1 further comprising the step of:

d) said user implements at least one of said web clipping applications to access and retrieve information from a web-site via said proxy server.

6.   The method of Claim 5 wherein said step d) of said user implements at least one of said web clipping applications to access and retrieve information is comprised of steps:

d1) said user implements at least one of said web clipping applications;

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d2) said at least one web clipping application commands a browser application within said installed software to seek web-site data associated with said at least one web clipping application;

d3) said browser accesses said proxy server and requests clipped data from said web-site associated with said at least one web clipping application; and

d4) said electronic device receives said clipped data requested by said browser from said proxy server.

7.   The method of Claim 5 wherein said step d) of said user implements at least one of said web clipping applications to access and retrieve information is performed without registration of said electronic device during said access and without a transfer of user authorization information.

8.   The method of Claim 1 wherein said installed software upon said electronic device is a result of a step preceding said step a) of preventing a user from accessing web clipping applications, said step preceding comprising:

downloading said software from said proxy server onto said electronic device.

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9.   A method for secure access of a proxy server by a portable information device (PID) wherein recurring device identification is eliminated, comprising the steps of:

a)   loading a software package onto said PID wherein said software package comprises a registration application and multiple hidden web clipping applications;

b)   registering said PID by the implementation of said registration application by a user;

c)   upon said registering said PID, commanding said PID to reveal said web clipping applications;

d)   initiating a browser command for clipped data from said PID, wherein said initiating is a result of the activation by said user of at least one of said revealed web clipping applications; and

e)   transmitting said clipped data to said PID.

10.   The method of Claim 9 further comprising the steps of:

d1)   accessing data on a web-site corresponding to said at least one of said revealed web clipping applications; and

d2)   clipping content on said web-site to create clipped data acceptable to said PID.

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11.   The method of Claim 9 wherein said step a) of loading a software package onto said PID is comprised of the step of:

downloading a software package from said proxy server via the Internet onto said PID.

12.   The method of Claim 9 wherein said step of loading a software package onto said PID is without cost to said user and without restriction to the acquirement of said software package by said user.

13.   The method of Claim 9 wherein said web clipping applications allow a user of said PID to access data and services on a proxy server without cost to said user and without registration of said user during said access of data and services.

14.   The method of Claim 9 wherein said web clipping applications are hidden inside said registration application.

15.   A system comprising:

a proxy server coupled to the Internet; and

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an electronic device comprising a processor coupled to a bus and a memory coupled to said bus, said memory having installed software for accessing said proxy server and having stored therein instructions for implementing a method comprising the steps of:

a) preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software;

b) said user registering said electronic device with said proxy server using a registration application of said installed software; and

c) upon authorized registration of said electronic device with said proxy server, allowing said web clipping applications to be made available for use by said user and otherwise preventing access of said web clipping applications by said user.

16.   The system of Claim 15 wherein said electronic device is a personal information device (PID) comprising handheld organizers. cellular phones, laptop computers, and pagers.

17.   The system of Claim 15 wherein said step a) of preventing a user from accessing web clipping applications implemented by said electronic device is comprised of:

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preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software by hiding said web clipping applications within said installed software until such time that said device is registered with said proxy server.

18.   The system of Claim 15 wherein said step c) of allowing said web clipping applications to be made available implemented by said electronic device is comprised of:

upon authorized registration of said electronic device with said proxy server, revealing said web clipping applications to said user and otherwise preventing access of said web clipping applications by said user.

19.   The system of Claim 15 wherein said method implemented by said electronic device further comprises the step of:

d) said user implements at least one of said web clipping applications to access and retrieve information from a web-site via said proxy server.

20.   The system of Claim 15 wherein said installed software upon said electronic device is a result of a step preceding step a) of preventing a user from accessing web clipping applications, comprising the step of:

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downloading said software from said proxy server onto said electronic

device.